

REMARKS

INTRODUCTION

Claims 42-103 were and remain pending.

Claims 42-103 stand rejected.

No claims are amendeded herein.

No new matter has been added.

REJECTIONS UNDER 35 USC § 103

Claims 42-103 stand rejected as obvious over U.S. Patent 6,754,905 to Gordon et al. (hereafter "Gordon") in view of U.S. Patent 6,356,664 to Dunn et al. (hereafter "Dunn").

The rejections are traversed on three grounds. First, the Dunn reference does not qualify as prior art against the present application. Second, portions of Gordon do not qualify as prior art. Third, the rejection fails to establish a prima facie case of obviousness because the Office has not set pointed out how Gordon is supported by the provisional application on which it must rely to qualify as prior art against the present application.

PRIORITY DATE OF PRESENT APPLICATION: 27 JULY 1998

The file wrapper of the present application includes numerous documents which establish the present application's effective filing date, or priority date, as July 27, 1998. The present application claims priority under 35 USC § 371 to PCT Application PCT/IL99/00412, filed 27 July 1999. That PCT Application claims priority to PCT application PCT/IL98/00349, filed 27 July 1998. PCT/IL98/00349's claim of priority to PCT/IL98/00349 was perfected with a priority document filed 24 Aug. 1999. The priority date of the present application is acknowledged by the PTO in at least the following documents in the present application's file wrapper: International Preliminary Examination Report; PCT Notification of Election; Notification

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of Missing Requirements mailed 27 Feb 2001; Notification of Acceptance of Application mailed 9 May 2001 ("Priority Date 27 July 1998"); etc. In sum, Applicant has claimed and perfected a priority date of 27 July 1998.

Dunn Unavailable, Reference Date: 24 Feb 1999

On its face Dunn was filed 24 Feb. 1999 and has no earlier priority date. Dunn is clearly not prior art relative to the present application; Dunn's date of 24 Feb 1999 *postdates* the present application's date of 27 July 1998.

Withdrawal of the rejection is respectfully requested.

Gordon Reference, Filed 15 April 1999, Available Only Via 102(e): Portions Not Supported by Provisional Application

Gordon was filed 15 April 1999 and claims priority to U.S. provisional application 60/093,891, which was filed 23 July 1998 and which *predates* the present application. Therefore, Gordon only qualifies as prior art based on the provisional application per 35 USC § 102(e). Any teaching in Gordon relied on to reject the present claims must find support in the provisional application (see discussion in next section, "Prima Facie Case Not Established"). The rejection is traversed because various teachings of Gordon relied on to reject the claims are not found in Gordon's provisional application. Consider at least the following teachings of Gordon that have no equivalent disclosure in provisional application 60/093,891:

Claim	Cited Portion of Gordon	Not In Provisional
78	col. 11, lines 1-62	lines 13-26
78	Figure 7	all
78	col. 23, lines 28-67; col. 24, lines 1-20; col. 27, lines 12-43	all
claims 78, 80	col. 23, lines 57-67; col. 24	all

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	lines 1-19	
claim 79	Figure 7	all
claim 81	Fig. 11A 620 and col. 32 lines 62-67, col. 33 lines 1-7	all
claim 84	Fig. 6; col. 20 lines 27-49; col. 20 lines 6-25	all
85	col. 20, lines 6-25	all
others		

The portions discussed above are not complete; at a glance it appears that other portions of Gordon are not supported by its provisional application. The rejection is traversed because significant portions of Gordon have an art date of 15 April 1999 and therefore *postdate* the 27 July 1998 priority date of the present application.

Withdrawal of the rejection is respectfully requested.

Prima Facie Case Not Established

As discussed above, Gordon, filed in 1999, can only qualify as prior art under 35 U.S.C. § 102(e). Any teachings in Gordon *must* have § 112, first paragraph support in provisional application 60/093,891, to which Gordon claims priority. Furthermore, to make a prima facie case, it is the *Office* that bears the burden of showing such support. As stated in *In Re Wertheim*, 646 F.2d 527, 531-39, 209 USPQ 554, 559-66 (CCPA 1981):

"If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it [the PTO] must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent."

As further stated in *Wertheim*: "Any earlier U.S. filing date for the patent necessarily depends on further compliance with §§ 120 and 112." *Wertheim*, 646 F.2d at 538, 209 USPQ at

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565. As guidance only, Applicant notes the following quotation from a recent BPAI decision (Appeal 2006-1736, emphasis added):

The Examiner should further explain how and where that ... [earlier-filed] application supports, in the manner provided by § 112, first paragraph the subject matter of the relied upon ... such that a § 102(e) date based on that earlier ... application filing may be accorded the Gabrys' patented subject matter relied upon by the Examiner in rejecting the claims. ... In this regard, in order to rely on a document as prior art with respect to the appealed claims under 35 U.S.C. §§ 102(e) and 103(a), the Examiner must establish that the document is in fact applicable as prior art to the claims.

The rejection based in part on Gordon is traversed because the Office has not explained where § 112, first paragraph support for Gordon's teachings can be found in the provisional application that qualifies Tripp as prior art. A prima facie case has not been established.

Withdrawal of the rejection is respectfully requested.

ANY NEW REJECTION MUST BE NON-FINAL

Any new Office Action must be Non-Final. Both the Gordon and Dunn references were relied on in the Non-Final Office Action of 27 July 2006 and in the Final Office Action of July 5, 2007. *Any new ground of rejection cannot have been necessitated by Applicant's 27 Nov 2006 amendment to the claims.* Therefore, any new Action should be Non-Final.

CONCLUSION

The present application is in condition for allowance. A prompt action to such end is requested.

Should any fees be required in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-0463.

If the Examiner believes a telephone interview would be helpful to expedite prosecution, the Examiner is invited to contact Applicant's undersigned representative at the telephone number below.

Respectfully submitted,
Microsoft Corporation

Date: 9 Oct 2007

By: /James T. Strom/

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9 Oct 2007
Date



Darcy Kobylarczyk

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